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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,722	12/10/2004	Peter Neu	00143-00244-US	6059
23416 7590 03/16/2007 CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899			EXAMINER ARNOLD, ERNST V	
			ART UNIT	PAPER NUMBER
			1616	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/16/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.		Applicant(s)	
	10/517,722		NEU ET AL.	
	Examiner		Art Unit	
	Ernst V. Arnold		1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4 and 7-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4 and 7-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/21/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/20/06 has been entered.

Claims 1, 5, 6, and 12-17 have been cancelled. Claims 2-4 and 7-11 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-4 and 7-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 7 recites "a treatment of conditions selected from the group consisting of" and then recites improvements of blood flow, impairments of blood flow in the brain, impairment of cerebral perfusion, coronary perfusion impairment, cognitive impairment, improving the oxygen supply in the brain, for promoting blood flow in the brain, for improving oxygenation of the body for improving the oxygenation of the brain. It is unclear how these impairments are conditions. It is unclear how improving something makes it a condition. It is unclear how promoting something is a condition. On the other hand, spasms, vasospasms, cerebral vasospasms, and stroke are conditions. Claims 2-4 and 8-11 are rejected as being indefinite because they are dependent on an indefinite base claim.

Claims 2-4 and 7-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to the Examiner if Applicant intends for claim 7 to be a Jepson type claim because the improvement is not recited. If so then proper Jepson claim language is required. See MPEP 608.01(m). Claims 2-4 and 8-11 are rejected as being indefinite because they are dependent on an indefinite base claim.

Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 11 recites "includes an NO source for supplying oxygen to spontaneously breathing patients". It is unclear to the Examiner how the NO source is providing oxygen when it provides nitric oxide. The Examiner will interpret the claim as it reads on an NO source present.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2-4 and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Petzelt et al. (WO 00/53192) in view of Thomas (US 6,358,536) and Zapol et al. (US 6,656,452).

Applicant claims a method of treating a patient characterized in that a xenon spasmolytic is provide in a form of a combination medicament.

Determination of the scope and content of the prior art

(MPEP 2141.01)

Petzelt et al. disclose preparations and methods of use of xenon or xenon gas mixtures for treating neurointoxications (a chronic cerebral disorder such as Parkinson's disease; thus an impairment of cognitive performance) in a therapeutically useful concentration (Page 5, paragraph 1; page 11, paragraph 4 and claims 1, 7 and 16, for example). Petzelt et al. teach the use of the gas or gas mixtures where the neurointoxication is craniocerebral trauma (claims 1-3 and 8). Petzelt et al. clearly point towards a method of treating apoplexy thus encompassing stroke (Claim 4). The preparation can have a ratio of xenon to oxygen of 80 to 20 percent by volume thus reading on instant claims 1-3 (Page 8, second paragraph and claims 15 and 17). Administration is by simple inhalation (Page 12, line 1). Methods of mixing the gases are provided (Page 8, paragraphs 3 and 4). Methods of administration are also provided (Page 9, paragraphs 1 and 2). Petzelt et al. teach a method of producing an inhalable preparation by mixing xenon with another gas harmless for humans (Claim 18).

Thomas teaches methods of alleviating or preventing vasoconstriction or vasospasm in a mammal via administration of a NO source (Abstract). The NO source can be nitroglycerine, arginine and a nitroprusside salt (claims 1, 9 and 10).

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Zapol et al. teach use of a therapeutically effective amount of inhaled NO gas for treating ischemia reperfusion, stroke and trauma; for example (Abstract, column 2, lines 50-55 and claim 1). Zapol et al. teach administering a therapeutically effective amount of a second compound that potentiates the therapeutic effect of gaseous nitric oxide (Claim 1). Nitric oxide is a known vasodilator (column 1, lines 22-40).

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Petzelt et al. do not expressly teach adding an NO source to their method of treating neurointoxications.

Finding of prima facie obviousness

Rational and Motivation (MPEP 2142-2143)

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use an NO source as defined by Zapol et al., in the method of Petzelt et al. and produce the instant invention.

One of ordinary skill in the art would have been motivated to do this because Petzelt et al. suggests adding another harmless gas, and a therapeutic amount of NO from an NO source would be beneficial to the patient as taught by Zapol et al. and Thomas. Since both methods are directed to the same purpose it would be obvious to combine xenon and NO especially in view of the fact that Petzelt et al. suggests other gases and Thomas and Zapol et al. teach using NO sources for treating the same conditions. "It is prima facie obvious to combine two compositions

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each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art.” In *re* Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill in the art might reasonably infer from the teachings. (*In re Opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA) 1976). Thus one of ordinary skill in the art would have immediately combined the two compositions, xenon and NO source, in the method of Petzelt et al. It is the Examiner’s position that mixing of xenon and NO gases would read on simultaneous administration and that it is within the purview of one of ordinary skill in the art to determine the best mode of administration on a patient by patient and condition dependent manner where separate or sequential administration might be most favorable for that case.

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill in the art might reasonably infer from the teachings. (*In re Opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA) 1976).

In light of the forgoing discussion, the Examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a). From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1) Claims 2-4, 7 and 9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2, 4, 6 and 7 of copending Application No. 10/517,723. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims embrace or are embraced by the copending claims. Instant claim 2 and copending claim 2 are drawn to therapeutically effective amounts of xenon. Instant claim 4 comprises a spasmolytic and xenon, which makes obvious copending claim 4 composition comprising xenon and a NO source. NO is a spasmolytic. Copending claim 6 and instant claims 2 and 3 are drawn to therapeutically effective amounts of NO and xenon. Copending claim 6 and instant claim 7 are drawn to the use of the xenon and a further spasmolytic. Copending claim 7 and instant claim 6 overlap in subject matter as they are drawn to the method of treating cerebral protection and cerebral vasodilation.

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One of ordinary skill in the art would have recognized the obvious variation of the instant claims in the copending application because of the overlap in claimed subject matter as stated above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

No claims are allowed.

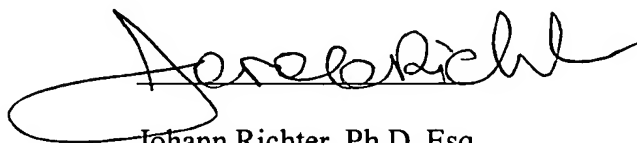
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernst V. Arnold whose telephone number is 571-272-8509. The examiner can normally be reached on M-F (6:15 am-3:45 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ernst Arnold
Patent Examiner
Technology Center 1600
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A handwritten signature in black ink, appearing to read 'Johann Richter', with a large, stylized loop at the beginning.

Johann Richter, Ph.D. Esq.
Supervisory Patent Examiner
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